

AMENDMENTS TO THE DRAWINGS:

Please replace previous sheets 1 to 3 of the drawings with replacement sheets 1 to 3 of the drawings for Figures 1 to 3, which accompany this response. Relative to the previous sheets of drawings, the replacement sheets have translated labels. Approval and entry are respectfully requested.

REMARKS

Claims 31 to 34 are added, and therefore claims 16 to 34 are currently pending.

Reconsideration of the application is respectfully requested based on the following remarks.

With respect to paragraph 1 of the Office Action, it asserts that the information disclosure statement, submitted at the time of filing of the present application, does not include a concise explanation of the relevance of each non-English patent listed. *Each non-English patent listed in the information disclosure statement is also listed in the international search report, a copy of which was also submitted at the time of filing of the present application, and this search report indicates the relevancy of each of these non-English patents, as it is presently understood. Therefore, Applicants respectfully submit that these references should be considered and made of record by the Office.*

With respect to paragraph 2 of the Office Action, the drawings were objected to because the labels contained therein remain un-translated. In response, three replacements sheets of drawings are herein included, containing corrected FIGS. 1 to 3, in which all labels have been translated. The translated labels are supported by the Specification and no new matter has been added. Therefore, it is respectfully requested that this objection to the drawings be withdrawn.

With respect to paragraph 4 of the Office Action, claims 16-26 and 30 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,052,471 to Van Ryzin (hereinafter the "Van Ryzin" reference).

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102(e), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the claimed subject matter of the claims, as discussed herein. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; and see *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, it is respectfully submitted that any anticipation rejection premised on the inherency doctrine is not sustainable absent the foregoing conditions.

Claim 16, as originally filed, is to *a control device for establishing an information-output ranking of a plurality of information sources including audio sources, comprising: an arrangement for establishing the information-output ranking in pairs for the audio sources in an information-output matrix set-up having a nonlinear order with respect to matrix elements; and an arrangement for outputting information from the information sources to a common information-output device.*

The “Van Ryzin” reference does not identically disclose (or even suggest) at least the above-identified claim features. Specifically, the “Van Ryzin” reference does not identically disclose (or even suggest) the feature of an arrangement for establishing an information-output ranking in pairs for audio sources in an information-output matrix set-up having a nonlinear order with respect to matrix elements, as provided for in the context of the claimed subject matter.

Regarding the information-output matrix set-up having a nonlinear order with respect to matrix elements, in making this rejection the Office Action relies upon certain portions of the “Van Ryzin” reference, including Fig. 3 and col. 5, lines 30-44. However, these portions of the “Van Ryzin” reference do not disclose anything akin to the information-output matrix set-up having the nonlinear order with respect to matrix elements. That is, Fig. 3 (and col. 5, lines 30-44) of the “Van Ryzin” reference clearly depicts a linear priority ordering of audio sources, i.e. CD is priority 1, tape is priority 2, AM/FM is priority 3, phone is priority 4, etc. That this is a linear order can be understood by considering that because the CD audio source has a higher priority of the next lower priority audio source, i.e., the tape audio source, it also transitively has a higher priority than everything lower in priority than the tape audio source.

By contrast, the presently claimed subject matter includes a nonlinear order. As described in more detail in the specification, in a non-linear order, the priority ordering of audio sources is not necessarily transitive. That is, in a non-linear order, if Item A is higher priority than Item B, and Item B is higher priority than Item C, then it is still possible for Item A to have a lower priority than Item C. However, the ordering depicted in Fig. 3 of the “Van Ryzin” reference does not disclose such a non-linear nature.

Therefore, the “Van Ryzin” reference does not disclose the information-output matrix set-up having the nonlinear order with respect to matrix elements, and thus the features of claims 16, as originally filed, including the features identified above, are not identically disclosed (or suggested) by the “Van Ryzin” reference.

Independent claim 23 also contains similar features as those discussed above, and accordingly claim 23, as originally filed, is allowable, as are the dependent claims of independent claims 16 and 23. It is therefore respectfully requested that the anticipation rejection of claims 16-26 and 30 be withdrawn.

With respect to paragraph 18 of the Office Action, claims 27 and 28 were rejected under 35 U.S.C. § 103(a) as unpatentable over the “Van Ryzin” reference in view of U.S. Patent No. 4,306,114 to Callahan (hereinafter the “Callahan” reference).

To reject a claim as obvious under 35 U.S.C. § 103, the prior art must disclose or suggest each claim feature and it must also provide a motivation or suggestion for combining the features in the manner contemplated by the claim. (See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990)). Thus, the “problem confronted by the inventor must be considered in determining whether it would have been obvious to combine the references in order to solve the problem”, Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 679 (Fed. Cir. 1998).

Claims 27 and 28 ultimately depend from independent claim 16, and are therefore also allowable for the same reasons, since the critical deficiencies of the “Van Ryzin” reference with respect to this independent claim are not cured -and are not asserted to be cured -by the secondary reference. Therefore, withdrawal of the obviousness rejections is respectfully requested.

With respect to newly added claims 31 to 34, these claims do not add any new matter and are supported by the present application. Moreover, claims 31 to 34 depend from claim 16, and are therefore allowable for the same reasons as claim 16.

Accordingly, claims 16 to 34 are allowable.

CONCLUSION

Applicants respectfully submit that all pending claims of the present application are allowable. It is therefore respectfully requested that the objections and rejections be withdrawn. Prompt reconsideration and allowance of the present application are therefore respectfully requested.

Respectfully submitted,

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